

In re Patent Application of:  
**ROBERT M. HERRIN**  
Serial No. 10/721,962  
Filing Date: 11/25/2003

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**Remarks**

Applicant and the undersigned would like to thank the Examiner for his efforts in the continued examination of this application, requests the finality of the office action be retracted or Claims 1-19 and 46-56 remaining in the case be allowed.

Claims 1-19 and 48-56 (specifically claims 1, 8, 48, and 51) were rejected under 35 USC §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1, 4, 8, 48, and 51 are herein amended to particularly point out and distinctly claim the subject matter which applicant regards as the invention, as guided by the Examiner.

The Examiner reminds the Applicant and the undersigned that while features of an apparatus may be recited either structurally or functionally, claims directed towards an apparatus must be distinguished from the prior art in terms of structure rather than function. Respectfully, and as has been addressed in earlier responses to office actions on the merits of the claims, the first examiner in this case (Examiner Gene Kim for office actions dated 10/21/04, 2/1/05, 6/23/05, and 8/29/05) appears to have selected structural elements from the teachings of the Applicant, and arbitrarily identified structural elements from the cited Tharpe '906 reference without thought as to whether or not the element can work together to provide the apparatus being claimed. Indeed they cannot, as supported by the Declarations of Herrin and Tharpe.

The above referenced office action includes a Restriction of claims 46-47 with a understanding by the Examiner that they are directed to a non-elected invention. Based on the following claim comparison (Claim 1 versus Claim 46) which would appear to show that each claim includes the same structure, the Applicant and the undersigned are puzzled as to why a Restriction is necessary.

1. An apparatus comprising:

(A1) a platen operable for moving between a first position proximate and in spaced relation to a

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blank and a second position through a biasing of the platen against the blank and a driving of the blank downstream therefrom, the platen having a guide plate operable at a peripheral portion thereof for providing a compression surface;

(A46) a platen operable for movement along a path therefor between a first position and a second position;

(B1) a forming rail positioned downstream the first position for receiving the blank moving thereby and folding portions thereof, wherein a proximal portion of the forming rail partially folds peripheral portions of the blank and a distal portion of the forming rail secures the blank into a partially formed tray, wherein the side walls are fully formed, the distal portion having a side folding rail portion opposing the guide plate for receiving the blank peripheral portions therebetween;

(B46) a forming rail positioned downstream the first position;

(C1) a first folding arm movably positioned for biasing against an extended portion of the partially formed tray for a folding thereof, the first folding arm positioned proximate the distal portion of the forming rail and downstream the proximal portion thereof, wherein the first folding arm is movable between a position allowing the platen to move thereby along a path of the platen to a position within the path and generally perpendicular thereto;

(C46) a first folding arm rotatable about an axis thereof, the first folding arm positioned proximate a distal portion of the forming rail and downstream a proximal portion thereof, wherein the first folding arm is movable between a position for allowing the platen to move thereby along the path to a position within the path;

(D1) a compression plate movably carried in spaced relation to the partially formed tray;

(D46) a compression plate;

(E1) a fixed plate carried in spaced relation to the compression plate and , the fixed plate having a surface thereof generally parallel to the path of the platen, the fixed plate and the compression plate forming a passage therebetween; and

(E46) a fixed plate carried in spaced relation to the compression plate, the fixed plate having a surface thereof generally parallel to the path of the platen, the fixed plate and the compression plate forming a passage therebetween, wherein the compression plate is moveable toward the fixed plate; and

(F1) a second folding arm movable through the passage and positioned for biasing against the extended portion of the partially formed tray and for folding the extended portion through the passage, wherein the fixed plate is positioned for guiding the extended portion along the surface of the fixed plate onto a tray wall for providing a fully formed tray.

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(F46) a second folding arm rotatable about an axis thereof for movement through the passage, the axis of the second folding arm being generally perpendicular to the axis of et first folding arm.

The amendments herein presented are intended to overcome the §112 rejection and do not affect the scope or breadth of the claims. The Restriction appears to be made in error based on the elements contained in the claims when compared to the claims being examined.

With regard to the need for an additional search, as suggested in the Advisory Action of 08/15/2006, the examining group is asked to consider the number of searches that have already taken place, and is asked to reconsider the current position based on the material presented in support of patentability and allowance of this application.

A 1<sup>st</sup> search resulted in the office action of 02/01/2005 where Tharpe '906 was cited as anticipating the claimed invention.

A 2<sup>nd</sup> search was likely completed after a response from Applicant, and in the office action of 06/23/2005 the Examiner maintained the §102 rejection based on the same single Tharpe '906 reference.

A 3<sup>rd</sup> search was performed as stated in the interview summary of 08/29/2005, which search was felt to be needed after a telephone interview and agreed to amendment of the claims for clarification and a filing of an RCE to allow such a search and reconsideration of the claims. The 3<sup>rd</sup> search resulted in the same interpretation of the prior art and conclusion that while not anticipated by Tharpe '906, the claims were obvious based on the Examiner's interpretation of the teachings of Tharpe '906 and engineering choice. The filing of an RCE resulted in the office action of 10/06/2005 including a §103 rejection citing the only the single Tharpe '906 reference.

A 4<sup>th</sup> search was likely completed by a new Examiner following arguments and declarations presented by the Applicant and Johnny Marion Tharpe, the named co-inventor of the Tharpe '906 reference. The office action of 06/28/2006 resulted. Again the same opinion and interpretation of the Tharpe '906 was restated. In addition, while

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declarants Tharpe and Herrin were recognized as being skilled in the art, the statements presented by the both declarants were not considered because the declarants were felt to be biased. Respectfully, another search should not be needed as presented in the Advisory Action of 08/15/2006, nor will it overcome the facts supporting patentability that have been presented by the Applicant.

To support the concern for bias expressed by the examining group, and in support of arguments presented regarding nonobviousness based on a single reference and interpretation, two declarations are now presented. The declarants are people skilled in the art and experienced with the forming apparatus disclosed in the cited Tharpe '906 reference and the apparatus disclosed and claimed by the Applicant. Each declarant deals with the Applicant at "arms length."

Declarant Mark Kenyon expresses in his Declaration that a modification of the Tharpe '906 tray former was not an option as the forming elements making up the structure of the Applicants tray former and their relationship to each are very different. It was clear that a tray former different from that of Tharpe '906 was needed, and resulted in a purchase of the Applicant's tray former. Declarant Kenyon further supports a contradiction to the Examiner's interpretation of the teachings of Tharpe '906. Based on review of the apparatus described by the Tharpe '906 patent and the Herrin apparatus that is the subject of the above application, it was clear that a modification to the Tharpe '906 apparatus was not an option if his company wanted to have a tray former to form the double glued corner tray structure. It is Declarant Kenyon's opinion that the teachings of the Tharpe '906 do not provide sufficient guidance to make modifications that result in the apparatus of Herrin.

Further, Declarant Lieffort expresses in his Declaration that attempts were made to modify this the Tharpe '906 apparatus to form the double glued corner style tray disclosed by the Applicant. Even with a "total redesign of the forming elements," he was unsuccessful in attempts to modify the apparatus described in the Tharpe '906 patent to

provide the structure described by the Applicant. Based on these failed attempts to modify the Tharpe '906 apparatus, his company purchased the Applicant's apparatus. Declarant Lieffort states that it is very clear to him that the combination of elements used in the Applicant's apparatus are significantly different than those described in the Tharpe '906 apparatus. It appears to Declarant Lieffort that the Examiner has taken features described in the Tharpe '906 for one tray forming apparatus and determined that the Tharpe '906 patent would allow one of skill in the art to make the Applicant's apparatus with engineering choice, but in fact his experience with the Herrin apparatus and the Tharpe '906 apparatus would show otherwise. Changes to the apparatus disclosed in Tharpe '906 were made in an attempt to construct the Herrin apparatus. The changes could not provide the structure of the Herring apparatus, and could not be used to form the desired tray structure that the Herrin apparatus could form. He concludes that the teachings of the Tharpe '906 patent do not provide sufficient guidance to one skilled in the art to make modifications that result in the apparatus of the Applicant.

The Examiner is asked to consider the need for a *prima facie* case for obviousness. It is understood that while the Office has the initial burden of producing a factual basis for a rejection under §103, the Applicant is obliged to provide rebuttal with a showing of facts supporting the opposite conclusion. The arguments provided during prosecution of this application and the Declarations herein presented support a conclusion of non-obviousness. Respectfully, the Examiners must consider all the evidence anew, and an earlier conclusion should not be regarded as set in concrete, as would appear to have been happening based on identical restatements for the reason for the rejection.

The Examiner is asked to consider the fact that those skilled in the art attempted, and failed to produce desirable results provided by the claimed invention using the teachings and specifically the embodiment described in the cited prior art should be

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sufficient evidence that the claimed invention is not obvious to those of skill in the art, as suggested in the office actions. An interpretation of the teachings of Tharpe '906 stating or at least implying that the innovations provided by the Applicant are simply a matter of engineering choice should be seen as carrying little weight in light of the evidence that those skilled in the art tried and failed to solve the same problem addressed by the Applicant, and later adopted the solution of the Applicant by purchasing a embodiment of his invention, the embodiment that is in fact the subject of the claims pending in this case.

As evidenced by the Declarations herein presented, commercial success resulted as a result of the claimed invention, not because of promotional efforts or a strong marketing effort directed to unclaimed features. Commercial success clearly resulted from features of the claimed invention, an invention that solved a problem and satisfied a need that was not able to be achieved by those skilled in the art.

Applicant asks that the Declarations of Jim Lieffort and Mark Kenyon be entered. As supported by 37 CFR 116(e), an affidavit or evidence submitted after a final rejection may be admitted upon a showing of good and sufficient reason why the affidavit or other evidence is necessary and was not earlier presented. As above addressed, Declarations of the Applicant (Robert M. Herrin) and Johnny Marion Tharpe (named co-inventor of the cited Tharpe '906 reference) were submitted in response to the non-final office action of 10/06/2005. The material in support of patentability and non-obviousness contradicting the interpretation of the Examiners was not considered because it was felt the declarants were biased. Declarants Lieffort and Kenyon have dealt with the Applicant at arms length. They represented companies regularly using tray forming machines and have specifically used the apparatus disclosed in Tharpe '906. The declarants are clearly skilled in the art. They attempted to modify the Tharpe '906 apparatus to that of the Applicants and failed in their attempts. Clearly, this shows good and sufficient reason why the declarations herein presented must be entered and

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considered.

Applicant further asks that this application be allowed. Should the examining group feel further discussion is needed, the Examiner is asked to contact the undersigned at his convenience. Further, it should now be appropriate that the finality of the pending office action be retracted.

Applicant and the undersigned would like to again thank the Examiner for reconsidering the claims herein presented and the Declarations presented in support of allowance of the application. Failing to convince the Examiner of the correctness in allowing this application, Applicant asks that the above presented amendments and declarations be entered to place this application in a better condition for appeal.

If the further prosecution of the application can be facilitated through telephone interview between the Examiner and the undersigned, the Examiner is requested to telephone the undersigned at the Examiner's convenience.

Respectfully submitted,



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